



FEB 19 2002

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7©
:

MEMORANDUM AND ORDER

(petitioner) received a grade of 67 on the April 18, 2001 Registration Examination, and petitions for regrading his answers to three (3) questions consisting of: questions 34 and 50 of the morning section and question 36 of the afternoon section. Each question in the Registration Examination is worth one point. A petition fee of \$230 has been submitted

Credit has been given for morning question 34 and afternoon question 36 thereby producing a corrected score of 69. A score of 70 is required as the passing grade.

Accordingly, the petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a combined passing grade of 70

from both the morning and afternoon sections of the Registration Examination.

Petitioner's initial combined score was 67. On August 6, 2001 (with a certificate of mailing date under 37 CFR 1.8 of July 30, 2001) petitioner requested regrading, arguing that certain model answers were incorrect.

As indicated in the instructions for requesting regrading of the Registration Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of

practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of certain of the model answers. All of petitioner's arguments have been fully considered.

Petitioner has been awarded an additional one (1) point for morning question 34 and an additional one (1) point for afternoon question 36. Accordingly, petitioner has been granted an additional two (2) points on the Registration Examination. No credit has been awarded for morning question 50. Petitioner's argument related to morning question 50 is addressed below.

Morning question 34 reads as follows:

34 – 36. The following facts apply to the following three questions. For purposes of these questions, it should be assumed that the statutes and regulations effective as of April 18, 2001 apply for all time periods covered by the questions. Joseph, a citizen and resident of the United States, invented a new brake for in-line skates and filed a nonprovisional utility patent application in the USPTO on February 8, 2001. The application as filed included a specification and claims in compliance with 35 USC § 112, three sheets of publication quality drawings, an abstract of the disclosure, and an information sheet listing the name and address of the inventor. The application was initially filed without an executed inventor's oath or declaration and without the required filing fee. The Office issued a "Notice to File Missing Parts – Filing Date Granted" on April 2, 2001. The Notice informed Joseph that he must submit an executed oath or declaration by the inventor, pay the required filing fee, and pay a surcharge for late submission of these items within two (2) months of the date of the Notice. Joseph received the Notice on April 9, 2001. Joseph brought the Notice with him when he left for an extended overseas business trip the next day, April 10, 2001. Unfortunately, the Notice was placed in luggage that was lost during the trip. Upon his return to the United States on July 26, 2001, Joseph obtained a copy of the Notice and, on August 2, 2001 filed a Reply in full compliance with the Notice. A Petition for a two-month extension of time and all required fees accompanied the Reply. Joseph also requested waiver and a refund of fees associated with the Petition for extension of time on the basis that the delay was a result of his lost luggage and his extended trip overseas. In Joseph's view, even though he could have replied within the two-month period, it was unfair to penalize him for lost luggage. The request for waiver of fees was denied. A first substantive Office action on the merits of the application issued December 19, 2001 and set a three-month shortened statutory time for reply. All pending claims were rejected on the basis of prior art. Joseph filed a fully responsive Amendment on March 19, 2002, and a final Office action issued August 12, 2002 with a three-month shortened statutory period for reply. The final Office Action allowed certain claims and rejected other claims on substantially the same grounds set forth in the first Office action. Joseph filed a Notice of Appeal on September 19, 2002 and an Appeal Brief on March 18, 2003. A Petition for extension of time and proper authorization to charge a deposit account for any required fees accompanied the Appeal Brief. An Examiner's Answer issued on April 2, 2003, and Joseph filed a Reply Brief on April 15, 2003. The Board of Patent Appeals and Interferences reversed the Examiner's rejections on August 19, 2003. A Notice of Allowance and Issue Fee Due was mailed September 3, 2003. Joseph paid the Issue Fee on September 15, 2003 and the patent issued March 9, 2004.

34. The Office determined that the applicant failed to engage in reasonable efforts to conclude prosecution of the application. Which of the following statements is most true?

(A) Joseph is entitled to no patent term extension because neither the Uruguay Round Agreements Act nor the Patent Term Guarantee Act of 1999 applies to Joseph's patent

application.

(B) Although the Patent Term Guarantee Act of 1999 applies to Joseph's application, Joseph forfeited any patent term extension by failing to engage in reasonable efforts to conclude prosecution of the application.

(C) Joseph is entitled to a total patent term extension of approximately two (2) months because the application was pending for more than three (3) years.

(D) Joseph's successful appellate review adds approximately 11 months to any calculation of patent term extension.

(E) By replying to the Notice to File Missing Parts approximately two (2) months after the deadline set by the USPTO, Joseph reduced any patent term extension by two (2) months.

The model answer is selection (D).

See, 37 CFR §§ 1.702(e) and 1.703(e). Answer (A) is incorrect at least because the Patent Term Guarantee Act of 1999 applies to Joseph's application, which was filed after May 29, 2000. Answer (B) is incorrect because a failure to engage in reasonable efforts to conclude prosecution may reduce patent term extension, but is not a complete forfeiture of any extension. Answer © is incorrect because the three year period set forth in 37 CFR § 1.702(b) does not include time consumed by review by the Board of Appeals and Patent Interferences or any delay in processing of the application that was requested by the applicant. Answer (E) is incorrect because any reduction is based on an expected reply within three months of the Office action, regardless of the deadline set by the USPTO. See, 37 CFR § 1.704(b) and "37 CFR Part 1 Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rule," Federal Register Vol. 65, No. 181 at 56371.

Petitioner argues for answer (E).

It has been determined that credit will be given for morning question 34 where a petitioner argues for answer (E).

Accordingly, credit is given to petitioner for morning question 34.

Morning question 50 reads as follows:

50. An article in a popular scientific journal, dated January 13, 2000, fully discloses and teaches how to make a "Smart Shoe" wireless telecommunications device. The article discloses a shoe having a dialer in a rubber sole of the shoe. The article does not teach a metallic shoelace or suggest using the same as an antenna or for any other purpose. Which

of the following claims in an application filed January 22, 2001 is/are anticipated by the journal article, and is/are not likely to be properly rejected under 35 U.S.C. § 112, second paragraph as indefinite?

Claim 1. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and a metallic shoelace.

Claim 2. A telecommunications device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a metallic shoelace.

Claim 3. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a random access memory for storing telephone numbers.

(A) Claim 1.

(B) Claim 2.

(C) Claim 3.

(D) Claims 2 and 3.

(E) None of the above.

The model answer is selection (D).

MPEP § 2173.05(h), and Ex Parte Cordova, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989) and 35 U.S.C. § 102(b). (A) is incorrect since the article does not disclose a metallic shoelace, whereas Claim 1 requires a telecommunications device having a metallic shoelace. Since the "optional" element does not have to be disclosed in a reference for the claim to be anticipated, claims 2 and 3, which provide for inclusion of optional elements, are each anticipated by the article. Thus, (B), and (C), are incorrect. Inasmuch as [(C)] [sic] (D) is correct, (E) is incorrect.

Petitioner argues that answer (E) is the most correct answer. Petitioner believes answer (E) to be the most correct answer in that all the claims are likely to be rejected under 35 U.S.C. 112, second paragraph for aggregation pursuant to MPEP 2173.05. Therefore, the second of the two part test set forth in the question would not be satisfied and answer (E) None of the above is a correct answer.

In claim 2, there is no cooperation recited between the metallic shoelace and the other elements. In claim 3, there is no cooperation recited between the random access

memory and the other elements. Claims 2 and 3, however, are not likely to be properly rejected under 35 U.S.C. 112, second paragraph as indefinite, which rejection is required to meet the second part of the two part test. Preliminarily, as to claims 2 and 3, the issue of cooperation is not raised in that the metallic shoelace of claim 2 and the random access memory of claim 3 are both set forth as optional elements and can be viewed as not being present (thus their ability in meeting the first test of being subject to an anticipation rejection over the journal article). Moreover, the MPEP section referred to by petitioner in support of an aggregation rejection states "[N]either is a claim necessarily aggregative merely because elements which do not cooperate are set forth in specific detail." Other than labeling claims 2 and 3 aggregations, petitioner has not identified a prima facie case of indefiniteness that could support a rejection under 35 U.S.C. 112, second paragraph.

Answer (E) is not a correct answer.

Accordingly, no credit can be given for answer (E).

Afternoon question 36 reads as follows:

36. A member of the public submits a protest under 37 CFR § 1.291 relating to a public sale of the subject matter of a patent application (effective filing date June 1, 1999). The protest includes submission of a business circular authored by the assignee of the invention. In a first Office action dated January 10, 2001, the examiner includes a requirement for information requesting the date of publication of the business circular. The reply to the requirement for information states that the publication date is "approximately June 1, 2000." Which of the following would be proper for the examiner to include in the next Office action?

(A) A requirement that the date in the reply be made more specific.

(B) A holding that the previous reply is incomplete.

© A requirement seeking confirmation that "approximately June 1, 2000" is the most specific date that was obtained or can be obtained based on a reasonable inquiry if that is not already clear from the reply.

(D) (A) and (C).

(E) None of the above.

The model answer is selection (C).

37 CFR § 1.105 (effective November 7, 2000); "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54634 (September 8, 2000). The example at

65 FR 54634, column 2, states, "The examiner cannot require that the reply be more specific or hold the reply to be incomplete based on such information. The examiner can, however, in the next Office action seek confirmation that this is the most specific date that was obtained or can be obtained based on a reasonable inquiry being made if that is not already clear from the reply." Thus, answers (A) and (B) are incorrect and answer (C) is correct. Answer (D) is incorrect because Answer (A) is incorrect. Answer (E) is incorrect because answer (C) is correct.

Petitioner argues for answer (D).

It has been determined that credit will be given for afternoon question 36 where a petitioner argues for answer (D).

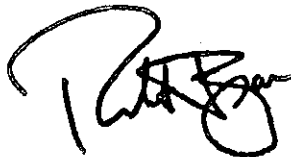
Accordingly, credit is given to petitioner for afternoon question 36.

ORDER

For the reasons given above, two (2) points have been added to petitioner's initial score of 67 on the Registration Examination. Therefore, petitioner's corrected score is 69. This score is insufficient to pass the Registration Examination as a score of 70 is required.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above a horizontal line.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy